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EXAMINER	
ART UNIT	PAPER NUMBER
	12

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

- 4 Mar 2003, 15 May 2003,  
25 Aug 2003
1. ☒ The communication filed 25 Aug 2003 is informal/non-responsive for the reason(s) checked below and should be corrected. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER ~~OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER)~~ WITHIN WHICH TO CORRECT THE INFORMALITY.
- a. ☒ The amendment to claim(s) 1-17, filed 25 Aug 2003, fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required. *(See attached discussion)*
- b. ☐ The paper is unsigned. A duplicate paper or ratification, properly signed, is required.
- c. ☐ The paper is signed by \_\_\_\_\_, who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required.
- d. ☐ The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.
- e. ☒ Other *(See attached discussion) - amendment format as per MPEP 714*
2. ☐ In accordance with applicant's request, THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED \_\_\_\_\_ IS EXTENDED TO RUN \_\_\_\_\_ MONTH(S).  
No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)
3. ☐ Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.
4. ☐ Other

See attachment:

- MPEP 714, copy
- Discussion

RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

5 November 2003

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1. Applicant's efforts in advancing prosecution in the instant case by papers filed in an attempt to respond to the 10 September 2002 office action are appreciated.

However, the requirements of 37 CFR 1.121, as referenced in MPEP 714 (see attached copy) have not been complied with in the *bona fide* set of filings that have been received, up to and including that which accompanies the 25 August 2003 petition to withdraw the holding of abandonment.

2. Please note the Manner of making amendments in application, as set forth in 37 CFR 1.121: Amendments in applications...are made by filing a paper...directing that specified amendments be made. Applicant has filed a substitute specification, with marked-up copy, a substitute set of claims, also with marked-up copy, and a set of substitute drawings. However, this collection of submitted documents does not constitute an instruction that satisfies the requirement for directing the changes.

3. Please note further that the PTO recommends the format as described in MPEP 714 (see attachment, paragraph bridging pages 5, 6), in which the clean version, remarks and marked-up version are combined into a single, coherent paper, with instructions further to enter the substitute specification and drawings. PTO technical support has informed the Examiner that the collection of copies as has been currently received do not meet such a format and cannot be properly entered.

4. Applicant's marked-up copy itself fails to adhere to the requirement of 37 CFR 1.121; that it must show all changes relative to the previous version of the specification, with underlining for added matter. Examples of this non-compliance can at least be seen at pages 27, 37, in the marked-up version of the substitute specification filed 25

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August 2003. The underlined blocks of content at the ends of these two pages, upon comparison to the originally-filed specification as received on 14 February 2000, turn out to comprise text that has not been added, but which was already contained in that originally-filed specification.

5. Applicant's set of substitute drawings, as filed 25 August 2003, also fails to comply with 37 CFR 1.121: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. No red-marked copy (i.e., the marked-up version of the drawings relative to those originally filed on 14 February 2000) has been received.


6. Though applicant supplies a statement that "no new matter" is included in the 15 May 2003 response to the letter indicating a non-compliant amendment that was mailed 18 April 2003, the Examiner wishes to point out the amendatory content at page 3 of the 25 August 2003 marked-up version of the specification. There, a description as to the details of "Chattercast™ scripts" has been inserted, without a *prima facie* appearance that the subject matter of this insertion was in fact part of the application as originally filed on 14 February 2000.

7. Applicant is therefore invited, in response to this letter, to produce and submit an amendment and response under 37 CFR 1.111 to the 10 September 2002 office action that is compliant under 37 CFR 1.121, by adhering to the guidelines as set forth in MPEP 714. Such a response would properly provide the required instruction directing the entry of the substitute specification, an instruction to amend the drawings by replacement with the substitute set of drawings as has been received (noting,

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additionally, that color drawings as per the proposed replacement fig 11 must be accompanied by a petition to accept color drawings pursuant to 37 CFR 1.84 (a)(2)), the remarks as supplied originally in the 4 March 2003 response, and a **correctly**-marked copy of the specification that shows the changes made in the substitute specification relative to the original copy of 14 February 2000. Additionally, applicant should supply the red-marked copy of the drawings to show changes, as further required by 37 CFR 1.121.

8. Applicant is again reminded that new matter may not be introduced by amendment under 37 CFR 1.121, and any substitute specification subsequently presented must be accompanied by a statement to this effect. While it is appreciated that the 14 February 2000 specification **does** make reference to the Chattercast <sup>TM</sup> product at page 2, paragraph 3, the embellishment upon this original description as proposed in the 25 August 2003 substitute specification must find full support in the original specification.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

5 November 2003



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## Manual of Patent Examining Procedure (MPEP)

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## 714 Amendments, Applicant's Action - 700 Examination of Applications

### 714 Amendments, Applicant's Action [R-1]

 37 CFR 1.121 Manner of making amendments in application.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825).*-

(1) *Amendment by instruction to delete, replace, or add a paragraph.* Amendments to the specification, other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as

provided in §§ 1.77(b), 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

- (i) A reference to the section heading along with an instruction to delete that section of the specification and to replace such deleted section with a replacement section;
- (ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and
- (iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

→ (3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

- (i) An instruction to replace the specification;
- (ii) A substitute specification in compliance with § 1.125(b); and
- (iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification. The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) *Reinstatement:* Deleted matter may be reinstated only by a subsequent amendment presenting the previously deleted matter.

→ (c) *Claims.* -

(1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

→ (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

→ (d) Drawings. Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

→ (f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments:* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2) or (c)(1) of this section is not required.

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(i) *Amendments in reexamination proceedings:* Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913 must be made in accordance with § 1.530(d)-(j).

(j) *Amendments in provisional applications:* Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

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## I. < WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of **37 CFR 1.116**; and

(C) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of **37 CFR 1.121**. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

>

## II. < MANNER OF MAKING AMENDMENTS

After March 1, 2001, all amendments to the specification, including the claims, must be made by replacement paragraph/section/claim in clean form (without underlining and bracketing) in order to eliminate (1) the need for the Office to enter changes to the text of application portions by handwriting in red ink, and (2) the presence of hard to scan brackets and underlining to improve the patent publishing process. This practice requires the applicant to provide a clean copy of an amended paragraph/section/claim together with a marked up version using applicant's choice of a marking system showing the changes being made which will aid the examiner. The marked up version must be based on the immediate previous version and indicate (by markings) how the previous version has been modified to produce the clean replacement paragraph(s), section(s), specification or claim(s) submitted in the current amendment. "Previous version" is defined as the version of record in the application as originally filed or from a previously entered amendment.

### Amendments to the Specification

In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § **608.01**), page and line, or any other unambiguous method and be accompanied by the replacement paragraph(s) in clean form.

Where paragraph numbering has been included in an application as provided in **37 CFR 1.52(b)(6)**, applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

**37 CFR 1.121(b)(1)(ii)** requires that the replacement or added paragraph(s) be in clean form. This means that the added or replacement paragraph(s) must not include any markings to indicate the changes that have been made. **37 CFR 1.121(b)(1)(iii)** requires that a separate version of the replacement paragraph(s) accompany the amendment. The separate version must include each replacement paragraph with markings



to show the changes relative to the previous version as an aid to the examiner. A marked up version, however, does not have to be supplied for any added paragraph(s) or any deleted paragraph(s), as it is sufficient to merely indicate or identify any paragraph that has been added or deleted.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided in clean form, that is, without any markings to show the changes that have been made. A separate marked up version showing the changes in the section relative to the previous version must accompany the actual amendment as an aid to the examiner.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any subject matter deleted by amendment can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

## Amendments to the Claims

All amendments to a claim must be presented in the form of a rewritten claim. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. See *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956)(amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation). Any rewritten or newly added claim must be submitted in clean form, that is, with no markings to indicate the changes that have been made\*\*. If a claim is amended by rewriting the claim with the same number, the amendment must be accompanied by a marked up version separate from the amendment using applicant's choice of marking system to indicate the changes being made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added, e.g., "amended," "twice amended," or "new," in both the clean version and the marked up version. A marked up version does not have to be supplied for any added claims or any canceled claims. If a marked up version is supplied to show changes made to amended claims, however, applicant should identify (in the marked up version) any added or canceled claims with a statement, such as, "Claim 6 has been canceled." A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

→ Applicants may submit a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not appear in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended. See MPEP § 714.13 for submitting a clean set of claims under 37 CFR 1.116 and MPEP § 714.16 for submitting a clean set under 37 CFR 1.312. See also MPEP § 714.22(a).

It is recommended that the following format be used by applicants in complying with the revised amendment practice requirements. The amendment paper should include, in the following order:

- (A) a clean version of the amended (replacement) paragraph(s)/claim(s);
- (B) a remarks section (beginning on a separate sheet); and
- (C) a marked-up version (also beginning on a separate sheet) showing changes and clearly identified as "Version with markings to show changes made."

The submission of a clean version of all pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining and bracketing, a marked up version should not be submitted.

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. See MPEP § 1302.04.

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### III. REVISED MANNER OF MAKING AMENDMENTS

Effective January 31, 2003, the Office is permitting applicants to submit amendments in a revised format as set forth below. All applicants including applicants participating in the Office's electronic file wrapper prototype may submit amendments in reply to Office actions using the revised format. The Office's electronic file wrapper prototype program is described in "USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING," 1265 O.G. 87 (Dec. 17, 2002), and applies only to Group Art Unit 1634, 2827, and 2834.

#### Waiver of 37 CFR 1.121

The provisions of 37 CFR 1.121(a), (b), (c), and (d) are waived for amendments to the claims, specification, and drawings in all applications in all Technology Centers where the amendments comply with the revised amendment format detailed below. The revised amendment format (and the waiver) does not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 for reissue applications and 37 CFR 1.530(d) - (k) for *ex parte* and *inter partes* reexaminations.

#### Revised Amendment Format

## 1. Begin on Separate Sheets

Each section of an amendment (e.g., Claim Amendments, Specification Amendments, Remarks) shall begin on a separate sheet to facilitate separate indexing and electronic scanning of each part of an amendment document for placement in an electronic file wrapper. For example, each of the following four sections of an amendment paper must start on a separate sheet:

- (A) Introductory Comments;
- (B) Amendments to the Specification;
- (C) Amendments to the Claims;
- (D) Remarks.

## 2. Two Versions of Amendment Part(s) No Longer Required

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section, substitute specification or claim will be waived where an amendment is submitted in the format noted below.

## 3. Amendment to the Claim

Each amendment document that includes a change to an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

(A) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated - formerly claim #\_), (previously reinstated), (re-presented - formerly dependent claim #\_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.

(B) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.

(C) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

(D) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and must not be underlined.

(E) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g., Claims 1 - 5 (canceled)).

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a green blue handle.

Claim 9 (withdrawn)

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (new): A bucket with plastic sides and bottom.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (re-presented - formerly claim 11): A black bucket with a wooden handle.

## **4. Amendments to the Specification**

Amendments to the specification are to be made by presenting a replacement paragraph, section or substitute specification marked up to show changes made relative to the immediate prior version. The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented.

## **5. Amendments to the Drawing**

Drawing changes must be made by presenting replacement figures which incorporate the proposed changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented in the remarks

section of the amendment. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. Any replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should not be labeled as "amended".

## IV. <AMENDMENT IN REEXAMINATION PROCEEDINGS

In patent-owner-filed reexaminations, the patent owner may amend at the time of the request for reexamination in accordance with **37 CFR 1.510(e)**. In any reexamination proceeding, no amendment or response can be filed between the date of the request for reexamination and the order for reexamination. See **37 CFR 1.530(a)**. Following the order for reexamination under **37 CFR 1.525** and prior to the examination phase of a reexamination proceeding, an amendment may be filed only with the patent owner's statement under **37 CFR 1.530(b)**. During the examination phase of the reexamination proceeding, an amendment may be filed:

- (A) after the first examination as specified in **37 CFR 1.112**;
- (B) after final rejection or an appeal has been taken, if the amendment meets the criteria of **37 CFR 1.116**; and
- (C) when and as specifically required by the examiner.

See also **MPEP § 714.12**.

For amendments in reexamination proceedings see **MPEP § 2250** and **§ 2266**.

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